



COPY OF PAPERS  
ORIGINALLY FILED

PATENT

Docket No: 744.708

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lee, Razgo  
Application No: 09/881,140  
Filed: June 14, 2001  
For: SELF-SIZING SUN VISOR  
Art Unit: 3765  
Examiner: — James G. Smith

RECEIVED  
MAR 27 2002  
H6  
H  
H552

March 15, 2002  
Assistant Commissioner for Patents  
Washington, D.C. 20231

**RESPONSE TO OFFICE ACTION**

Commissioner:

Applicant responds to the office action mailed on January 8, 2002 as follows:

**A. 35 U.S.C. §102 (b) Anticipation Rejection in Office Action Section 2**

MPEP § 2131 provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of Cahornia*, 814 F.2d 628,631,2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

In section 2 of the January 8, 2002 office action, the Examiner rejects claims 1-4, 10, 11, 12 and 16-19 under 35 U.S.C. §102 (b) as being anticipated by Cunliffe (5,966,742).

If the prior art reference relied upon by the examiner in a 35 U.S.C. §102 (b) rejection does not contain every element recited in the claim in as complete detail as is contained in the claim and arranged as recited in the claim, the rejection should be traversed as being improper.

**Applicant respectfully submits that contrary to the Examiner's statement that all elements are disclosed in the Cunliffe reference, the headband element is not, so the rejection is unsupported by the art and should be withdrawn.**

In the first paragraph of section 2, the Examiner states "Cunliffe discloses a self-sizing visor having a headband made of multiple elongated rectangular pieces. Cunliffe discloses a baseball-type cap not a visor. Cunliffe is titled, Adjustable Cap. The summary of invention states that the object of Cunliffe is to "provide a new and improved adjustable cap or hat." Cunliffe discloses in the Description of the Preferred Embodiment that "FIGS. 1 and 3 of the drawings illustrate an adjustable cap..." Cunliffe claims "a crown portion shaped for fitting over the crown of a wearer's head...the crown portion having a lower peripheral edge defining a head receiving opening..." Cunliffe claims "the crown portion is formed of a plurality of triangular gores which are sewn together along adjacent side edges with apices meeting at the crown of the cap..." Applicant respectfully submits that an enclosed crown portion made from a plurality of triangular gores which are sewn together is not a "self-sizing visor having a headband made of multiple elongated rectangular pieces" as the Examiner asserts.

Cunliffe discloses a two-part band "secured to the lower peripheral edge of the opening via stitching..." "The first, front part of the band is of a moisture absorbent, non-stretch material, and the second, rear part extending across the rear of the crown portion is of a stretchable material. The rear part of the band stretches to adjust the size of the peripheral opening to fit wearer's of differing head sizes." This type of band on the inside of a cap is universally called a sweatband. The band is not a part of the structure of the crown portion of the cap. Applicant respectfully submits that contrary to the Examiner's assertion the band does not have "a visor portion extending from the front portion of the bottom edge of the headband loop."

**Applicant respectfully submits that contrary to the Examiner's statement that all elements are disclosed in the Cunliffe reference, the visor element is not, so the rejection is unsupported by the art and should be withdrawn.**

Applicant respectfully submits that while the drawings included with the patent depict a bill or visor attached to the front of the crown of the cap no visor or bill is claimed. Figure 1 has 15 with an arrow pointing to what would normally be the bill/visor of a baseball-type cap. The Description of the Preferred Embodiment does not explain what the number 15 is identifying. The word visor is found only once in the entire patent. In fact, the word bill can be found only once in the entire patent. Both words are found in the Description of the Preferred Embodiment column 2 lines 27 and 28. The pertinent part of the passage states "and a bill or visor is projecting from the front part of the cap." In this sentence the term visor is equated to the bill of the cap. The exact location of the bill or visor is not disclosed. The means of attachment of the bill or visor to the cap is not disclosed.

Applicant respectfully submits that with respect to Claims 2 and 3, Cunliffe does not have a headband. "The crown portion is formed of a plurality of triangular gores which are sewn together along adjacent side edges with apices meeting at the crown of the cap." The Cunliffe two-piece band is a sweatband and not a headband. Therefore, Cunliffe does not have a headband with material referred to "as bi-axially stretchable (claim 1)" as the Examiner asserts.

Applicant respectfully submits that with respect to Claim 4, Cunliffe does not disclose or claim a headband. The sweat absorbing material is attached to the front part of the two-piece band (FIG. 1, detail 16).

**Applicant respectfully submits that contrary to the Examiner's statement that all elements are disclosed in the Cunliffe reference, the visor element is not, so the rejection is unsupported by the art and should be withdrawn.**

Applicant respectfully submits that with respect to Claims 10, 11, 18 and 19, Cunliffe does not disclose or claim a headband with at least one of the edges being curvilinear. Cunliffe does not disclose or claim a headband. Cunliffe does not disclose or claim a curved edge. The drawings show only straight edges.

Applicant respectfully submits that with respect to Claim 12, Cunliffe does not disclose or claim an adjustable cap having a headband comprised of one or more headband segments. Cunliffe does not disclose or claim a headband. The headband segments being connected forming an elongated four edge band. The two ends of the band are connected to form a closed loop.

Applicant respectfully submits that with respect to Claim 16, Cunliffe does not disclose a headband segment being sweat absorbent. Cunliffe does not disclose or claim a headband.

Applicant respectfully submits that with respect to Claim 17, Cunliffe does not disclose a headband comprised of multiple sections, some being biaxially stretchable and others being non stretchable. Cunliffe does not disclose or claim a headband.

Applicant respectfully submits that, in section 6, the Examiner fatally undermines his arguments in support of the rejection of claims 1-4, 10, 11, 12 and 16-19 under 35 U.S.C. §102 (b) as being anticipated by Cunliffe. In section 2, under a 35 U.S.C. §102 (b), the Examiner argued Cunliffe contained every element recited in claims 1-4, 10, 11, 12 and 16-19 in as complete detail as is contained in the claims and arranged as recited in the claim. In section 6, the Examiner states, "While Cunliffe essentially teaches the self-sizing sun visor he fails to explicitly disclose the makeup of the fabric used to make the visor." This lack of specificity regarding the fabric is an admission that this element is not present in Cunliffe. The Examiner applies the rejection of Claim 7 under 35 U.S.C §103 (a) as being unpatentable over Cunliffe to claims 1-6, 10, 11, 12 and 16-19 "and further in view of Yan (6,131,202)." Claims 1-6, 10, 11, 12 and 16-19 include claims 1-4, 10, 11, 12 and 16-19. The Examiner is acknowledging that Cunliffe lacks a claim element found in claims 1-4, 10, 11, 12 and 16-19 and is therefore an insufficient reference to support a rejection under 35 U.S.C. §102 (b).

Applicant respectfully submits that, in section 7, the Examiner fatally undermines his arguments in support of the rejection of claims 1-4, 10, 11, 12 and 16-19 under 35 U.S.C. §102 (b) as being anticipated by Cunliffe. In section 2, under a 35 U.S.C. §102 (b), the Examiner argued Cunliffe contained every element recited in claims 1-4, 10, 11, 12 and 16-19 in as complete detail as is contained in applicant's claims and arranged as recited in applicant's claims. In section 7, the Examiner states "However, Cunliffe fails to disclose the shape of the headband to be at it widest width at the wearer's forehead and be tapered to it smallest width in the rear of the wearer's head." This is an admission that the tapering element is not present in Cunliffe. The Examiner applies the rejection of Claim 8 under 35 U.S.C §103 (a) as being unpatentable over Cunliffe to claims 1-7, 10, 11, 12 and 16-19 "and further in view of Fleitman (5,377,360)." Claims 1-7, 10, 11, 12 and 16-19 include claims 1-4, 10, 11, 12 and 16-19. The Examiner is acknowledging that Cunliffe lacks a claim element found in claims 1-4, 10, 11, 12 and 16-19 and is therefore an insufficient reference to support a rejection under 35 U.S.C. §102 (b).

Applicant respectfully submits that, in section 8, the Examiner fatally undermines his arguments in support of the rejection of claims 1-4, 10, 11, 12 and 16-19 under 35 U.S.C. §102 (b) as being anticipated by Cunliffe. In section 2, under a 35 U.S.C. §102 (b), the Examiner argued Cunliffe contained every element recited in claims 1-4, 10, 11, 12 and 16-19 in as complete detail as is contained in applicant's claims and arranged as recited in applicant's claims. In section 8, the Examiner states "However, Cunliffe fails to disclose the shape of the headband being at its narrowest width at the wearers forehead and the widest width in the rear." This is an admission that the tapering element is not present in Cunliffe. The Examiner applies the rejection of Claim 8 under 35 U.S.C §103 (a) as being unpatentable over Cunliffe to claims 1-8, 10, 11, 12 and 16-19 "and further in view of Dalton (4,491,985)." Claims 1-8, 10, 11, 12 and 16-19 include claims 1-4, 10, 11, 12 and 16-19. The Examiner is acknowledging that Cunliffe lacks a claim element found in claims 1-4, 10, 11, 12 and 16-19 and is therefore an insufficient reference to support a rejection under 35 U.S.C. §102 (b).

Applicant respectfully submits that the 35 U.S.C. §102 (b) rejection of claims 1-4, 10, 11, 12 and 16-19 is improper.

#### **B. 35 USC §103 Obviousness Rejection in Office Action Section 4**

In section 4 of the January 8, 2002 office action, the Examiner rejects claims 5 and 6 under 35 U.S.C. 103 as being an obvious improvement of Cunliffe (5,966,742). The Examiner states "it would have been obvious to one of ordinary skill in the art at the time the invention was made to choose the length (viz. "short" or "long") since it has been held the general conditions of a claim are disclosed in the prior art, discovering optimum or workable ranges involves only routine skill in the art."

In either the single reference or plural references situation, MPEP § 2142 provides "the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made." "In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person."

**All Claim Limitations Must Be Considered Especially When Missing From the Prior Art**

When evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

Applicant respectfully submits that Cunliffe as modified by the Examiner does not disclose or claim a headband. Applicant respectfully submits that Cunliffe as modified by the Examiner does not claim a visor. Applicant respectfully submits that Cunliffe does claim an adjustable cap.

**There Must Be a Basis in the Art for Combining or Modifying References**

MPEP-§ 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicant respectfully submits that there is no teaching or suggestion in Cunliffe to support the Examiner's contention that "...it would have been obvious to one of ordinary skill in the art at the time the invention was made to choose the length (viz. "short" or "long")..." Cunliffe discloses a one sizes fits all adjustable cap. There is no reason or suggestion from the prior art references cited by the Examiner for why one of ordinary skill in the art would have been led to produce a one-size-fits-all cap in multiple sizes. The very concept of multiple cap sizes is the antithesis of Cunliffe.

**References Are Not Properly Combinable or Modifiable if Their Intended Function Is Destroyed**

If a prior art reference is cited that requires some modification in order to meet the claimed invention and such a modification destroys the purpose or function of the invention disclosed in the reference, one of ordinary skill in the art would not have found a reason to make the claimed modification.

Applicant respectfully submits that modifying Cunliffe from a one-size-fits-all cap to a multiple size cap destroys the purpose and function of Cunliffe's one-size-fits-all cap.

**C. 35 USC §103 Obviousness Rejection in Office Action Section 5**

In section 5 of the January 8, 2002 office action, the Examiner rejects Claim 13 under 35 U.S.C 103 (a) as being unpatentable over Cunliffe (5,966,742). The Examiner states "Cunliffe fails to clearly disclose the stitching to hold the absorbing layer to the headband be (sic) stretchable thread. However, it is well known in the art to substitute stretchable yarn for traditional yarn when the fit of a garment would be enhanced. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substitute (sic) traditional yarn with stretchable yarn to enhance the fit of the garment."

In either the single reference or plural references situation, MPEP § 2142 provides “the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made.” “In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person.”

**All Claim Limitations Must Be Considered Especially When Missing From the Prior Art**

When evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

Applicant respectfully submits that Cunliffe as modified by the Examiner does not disclose or claim a headband. Applicant respectfully submits that Cunliffe as modified by the Examiner does not claim a visor. Applicant respectfully submits that Cunliffe does claim an adjustable cap.

**There Must Be a Basis in the Art for Combining or Modifying References**

MPEP § 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicant respectfully submits that there is no teaching or suggestion in Cunliffe to support the Examiners contention that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have substitute (sic) traditional yarn with stretchable yarn to enhance the fit of the garment.” Applicant respectfully submits that Cunliffe did not disclose modifying Cunliffe by employing stretchable yarn to “hold the absorbing layer to the headband” because it was unnecessary. The part of the Cunliffe cap that the absorbing layer is attached to is not stretchable. The Cunliffe absorbing layer is also not stretchable. There was no reason to hold two non-stretchable components together with stretchable yarn. There is no reason or suggestion from the cited prior art reference for why one of ordinary skill in the art would have been led to stitch these non-stretchable portions of the Cunliffe cap together with stretchable yarn.

**References Are Not Properly Combinable or Modifiable if Their Intended Function Is Destroyed**

If a prior art reference is cited that requires some modification in order to meet the claimed invention and such a modification destroys the purpose or function of the invention disclosed in the reference, one of ordinary skill in the art would not have found a reason to make the claimed modification.

Applicant respectfully submits that Cunliffe did not disclose modifying Cunliffe by employing stretchable yarn to “hold the absorbing layer to the headband” because it was unnecessary. The

part of the Cunliffe cap that the absorbing layer is attached to is not stretchable. The Cunliffe absorbing layer is also not stretchable. There was no reason to hold two non-stretchable components together with stretchable yarn. Employing stretchable yarn as the Examiner suggests purpose of having this portion of Cunliffe non-stretchable. Cunliffe may not function when stitched together with stretchable yarn. This may be the reason that stretchable yarn was not disclosed or claimed.

#### **D. 35 USC §103 Obviousness Rejection in Office Action Section 6**

In section 6 of the January 8, 2002 office action, the Examiner rejects Claim 7 under 35 U.S.C §103 (a) as being unpatentable over Cunliffe (5,966,742) as applied to claims 1-6, 10, 11, 12 and 16-19 above, and further in view of Yan. The Examiner states, "While Cunliffe essentially teaches the self-sizing sun visor he fails to explicitly disclose the makeup of the fabric used to make the visor. Yam discloses the preferred fabric being made up of cotton and spandex making the hat stretchable for adjusting to different head sizes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the cap of Cunliffe with the cotton and spandex fabric of Yam to make a self-sizing hat that would be able to adjust to different head sizes. It is known in the art to use a fabric comprised of cotton and spandex to provide stretch to the cotton fabric for added versatility and better performance characteristics. The cotton and spandex fabrics known in the art offer a better customizable fit for the individual wearer."

In either the single reference or plural references situation, MPEP § 2142 provides "the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made." "In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person."

#### **All Claim Limitations Must Be Considered Especially When Missing From the Prior Art**

When evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

Applicant respectfully submits that Cunliffe as modified by the Examiner does not disclose or claim a headband. Applicant respectfully submits that Cunliffe as modified by the Examiner does not claim a visor. Applicant respectfully submits that Cunliffe does claim an adjustable cap.

#### **There Must Be a Basis in the Art for Combining or Modifying References**

MPEP § 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicant respectfully submits that there is no teaching or suggestion in Cunliffe to support the Examiners contention that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have “to have provided the cap of Cunliffe with the cotton and spandex fabric of Yam to make a self-sizing hat that would be able to adjust to different head sizes.” Cunliffe discloses a one sizes fits all adjustable cap. If the use of spandex fabric was so obvious, why didn’t Cunliffe disclose its use in the biaxially stretchable components of his cap? Yan defines spandex fabric as multi-axially stretchable. Multi-axially stretchable material would encompass biaxially stretchable as well as tri-axially stretchable and beyond. Cunliffe may only function with at the most a biaxially stretchable fabric. There is no reason or suggestion from the cited prior art reference for why one of ordinary skill in the art would have been led to use a multi-axially stretchable material such as spandex fabric.

### **References Are Not Properly Combinable or Modifiable if Their Intended Function Is Destroyed**

If a prior art reference is cited that requires some modification in order to meet the claimed invention and such a modification destroys the purpose or function of the invention disclosed in the reference, one of ordinary skill in the art would not have found a reason to make the claimed modification.

Applicant respectfully submits that modifying Cunliffe by employing in portions of the cap will destroy the functionality as claimed in Cunliffe. Yan defines spandex fabric as multi-axially stretchable. Multi-axially stretchable material would encompass biaxially stretchable as well as tri-axially stretchable and beyond. Cunliffe stretches horizontally around the lower peripheral edge and vertically to the crown apices. Using a material that stretches more than biaxially may rendered Cunliffe’s invention non-operable. Cunliffe may not function when stitched together with stretchable yarn. This may be the reason that Cunliffe did not disclose spandex.

### **E. 35 USC §103 Obviousness Rejection in Office Action Section 7**

In section 7 of the January 8, 2002 office action, the Examiner rejects Claim 8 under 35 U.S.C §103 (a) as being unpatentable over Cunliffe (5,966,742 as applied to claims 1-7, 10, 11, 12 and 16-19 above, and further in view of Fleitman (5,377,360). The Examiner states “Cunliffe essentially teaches a self-sizing visor having a headband. However, Cunliffe fails to disclose the shape of the headband to be at it widest width at the wearer’s forehead and be tapered to it smallest width in the rear of the wearer’s head. Fleitman discloses a headband with a widest width being at the wearer’s forehead and tapering off towards the back so that improper puckering of the fabric does not occur. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the cap of Cunliffe with the headband of Fleitman to make for a self-sizing headband that does not pucker.”

In either the single reference or plural references situation, MPEP § 2142 provides “the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made.” “In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person.”



### **All Claim Limitations Must Be Considered Especially When Missing From the Prior Art**

When evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

Applicant respectfully submits that Fleitman discloses and claims a sweatband and not a headband. Applicant respectfully submits that Cunliffe as modified by the Examiner does not disclose or claim a headband. Applicant respectfully submits that Cunliffe as modified by the Examiner does not claim a visor. Applicant respectfully submits that Cunliffe does claim an adjustable cap.

### **There Must Be a Basis in the Art for Combining or Modifying References**

MPER-§ 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicant respectfully submits that there is no teaching or suggestion in Cunliffe to support the Examiners contention that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have “provided the cap of Cunliffe with the headband of Fleitman to make for a self-sizing headband that does not pucker.” Cunliffe discloses a one sizes fits all adjustable cap. It has a crown made of triangular gore sections and a band stitched to the lower peripheral edge of the crown. Fleitman discloses a decorative, comfortable, ultra-absorbent sweatband secured at its ends to hold it in place around a body part. Fleitman tapers only at the ends of the sweatband. Fleitman claims that “wherein the ends of the water-absorber are tapered and the width of the tapered cloth element end portions are a sufficient amount less than the width of the cloth element retaining portion that when the sweatband is placed around a body portion the cloth element does not pucker. “ There is no reason or suggestion from Cunliffe to suggest that puckering was a problem with the headband. There is no reason or suggestion from Cunliffe to suggest why one of ordinary skill in the art would modify Cunliffe to incorporate a sweatband shaped to avoid puckering.

### **References Are Not Properly Combinable or Modifiable if Their Intended Function Is Destroyed**

If a prior art reference is cited that requires some modification in order to meet the claimed invention and such a modification destroys the purpose or function of the invention disclosed in the reference, one of ordinary skill in the art would not have found a reason to make the claimed modification.

Applicant respectfully submits that modifying Cunliffe to include the Fleitman sweatband would destroy the purpose and function of Cunliffe. Fleitman discloses a decorative, comfortable, ultra-absorbent sweatband secured at its ends to hold it in place around a body part. Cunliffe discloses a one-size-fits-all adjustable cap. Incorporating the Fleitman means of securing the ends of the sweatband into the Cunliffe cap requires the wearer to secure the cap to their head. The securing

means eliminates the need to have Cunliffe's biaxially stretchable triangular shaped rear gore panels incorporated into the crown of the cap. Cunliffe as modified to include Fleitman becomes a cap held to the head of the wearer only after the securing means is employed. Combining the references as suggested by the Examiner will destroy the claimed functionality of Cunliffe.

#### **F. 35 USC §103 Obviousness Rejection in Office Action Section 8**

In section 8 of the January 8, 2002 office action, the Examiner rejects Claim 9 under 35 U.S.C. §103 (a) as being unpatentable over Cunliffe (5,966,742 as applied to claims 1-8, 10, 11, 12 and 16-19 above, and further in view of Dalton (4,491,985). The Examiner states "Cunliffe fails to disclose the shape of the headband being at its narrowest width at the wearer's forehead and the widest width in the rear. Dalton discloses a headband having the narrowest width at the wearer's forehead and the widest width in the rear for added comfort to the wearer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the cap of Cunliffe with the headband of Dalton to make for a self-sizing headband that is more comfortable to the wearer."

In either the single reference or plural references situation, MPEP § 2142 provides "the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made." "In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person."

#### **All Claim Limitations Must Be Considered Especially When Missing From the Prior Art**

When evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

Applicant respectfully submits that Dalton discloses and claims a "head covering for the hairless scalp of women experiencing a total hair loss from chemotherapy" and not a headband. Applicant respectfully submits that Cunliffe as modified by the Examiner does not disclose or claim a headband. Applicant respectfully submits that Cunliffe as modified by the Examiner does not claim a visor. Applicant respectfully submits that Cunliffe does claim an adjustable cap.

#### **There Must Be a Basis in the Art for Combining or Modifying References**

MPEP § 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicant respectfully submits that there is no teaching or suggestion in Cunliffe to support the Examiners contention that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have "provided the cap of Cunliffe with the headband of Dalton to make for a self-sizing headband that is more comfortable to the wearer." Cunliffe discloses a

one-sizes-fits-all adjustable cap. It has a crown made of triangular gore sections and a band stitched to the lower peripheral edge of the crown. Dalton discloses a "head covering for the hairless scalp of women experiencing a total hair loss from chemotherapy." The Dalton "liner components are of a fleecy material to partially fill the interior of the head covering and thereby compensate for the wearer's loss of hair to render the appearance of a head covering worn over a full head of hair." It has "...the general appearance of a turban..." Contrary to the Examiner's assertion Dalton is a type of hat. It does not have a headband. There is no reason or suggestion from Cunliffe to suggest combining an adjustable cap with a "head covering for the hairless scalp of women experiencing a total hair loss from chemotherapy." There is no reason or suggestion from Cunliffe to suggest why one of ordinary skill in the art would modify Cunliffe to incorporate a head covering for women experiencing hair loss due to chemotherapy.

### **References Are Not Properly Combinable or Modifiable if Their Intended Function Is Destroyed**

If a prior art reference is cited that requires some modification in order to meet the claimed invention and such a modification destroys the purpose or function of the invention disclosed in the reference, one of ordinary skill in the art would not have found a reason to make the claimed modification.

Applicant respectfully submits that modifying Cunliffe to include the Dalton head covering for women experiencing hair loss due to chemotherapy would destroy the purpose and function of Cunliffe. Dalton discloses a type of hat that has the appearance of a turban. Cunliffe discloses a one-size-fits-all adjustable cap. Incorporating the Dalton hat into the Cunliffe cap would create a one-size-fits-all adjustable hat for women experiencing hair loss due to chemotherapy. Combining the references as suggested by the Examiner will destroy the claimed functionality of Cunliffe.

### **V. Nonanalogous Art Cannot Be Used To Establish Obviousness**

35 USC §103 requires that obviousness be determined on the basis of whether at the time the invention was made a person of ordinary skill in the art to which the subject matter pertains would have found the claimed invention as a whole obvious. Although one of ordinary skill in the art is presumed to be aware of all prior art in the field to which the invention pertains, he is not presumed to be aware of prior art outside that field and the field of the problem to be solved. Accordingly, in assessing the propriety of any assertion of prior art as a basis for a prima facie case of obviousness one must determine the scope or bounds of the knowledge of one of ordinary skill in the art. Art outside these bounds is nonanalogous.

Analogous art is all art that is either in the field of technology of the claimed invention or deals with the same problem solved by the claimed invention even though outside the field of technology of the invention.

The determination that a reference is from a nonanalogous art is therefore twofold. First, decide if the reference is within the field of the inventor's endeavor. If it is not, (second) we proceed to

determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

Applicant respectfully submits that Dalton is nonanalogous art. Dalton discloses a type of hat that has the appearance of a turban and functions as a head covering for women experiencing hair loss due to chemotherapy. Would destroy the purpose and function of Cunliffe. The Dalton "liner components are of a fleecy material to partially fill the interior of the head covering and thereby compensate for the wearer's loss of hair to render the appearance of a head covering worn over a full head of hair." Therefore, Dalton also functions as a prosthetic device simulating a full head of hair. One of ordinary skill in the art would not have been expected to look at a prosthetic hair-simulating hat to obtain guidance as to how to solve the problem of creating a self-sizing sun visor.

For the teachings of a reference to be prior art under Section 103, there must be some basis for concluding that the reference would have been considered by one skilled in the particular art working on the pertinent problem to which the invention pertains. The purpose behind Dalton is to provide a prosthetic hair-simulating hat. Dalton could be found in the medical devices field of endeavor. There are no common problems to be solved. Therefore, one skilled in the art would not have expected to reference a prosthetic hair-simulating hat to shed light on the subject of creating a self-sizing sun visor.

#### **G. 35 USC §103 Obviousness Rejection in Office Action Section 9**

In section 8 of the January 8, 2002 office action, the Examiner rejects Claims 14 and 15 under 35 U.S.C §103 (a) as being unpatentable over Cunliffe (5,966,742). The Examiner states "Cunliffe discloses a self-sizing headband comprised of multiple segments, but does not specifically disclose whether the different segments are the same color or different colors. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the cap of Cunliffe by either making the different segments of the headband the same color or different colors to enhance the aesthetic appeal of the headband."

In either the single reference or plural references situation, MPEP § 2142 provides "the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made." "In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person."

#### **All Claim Limitations Must Be Considered Especially When Missing From the Prior Art**

When evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

Applicant respectfully submits that Cunliffe does not disclose or claim a headband. Applicant respectfully submits that Cunliffe does not claim a visor. Applicant respectfully submits that Cunliffe does claim an adjustable cap.